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THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Trademark Management Company¹

Serial No. 78/074,430

Bert A. Collison of Duane Morris LLP for Trademark
Management Company.

Aretha C. Masterson, Trademark Examining Attorney, Law
Office 112 (Janice O'Lear, Managing Attorney).

Before Seeherman, Hairston and Rogers, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Trademark Management Company seeks to register
QUESADILLA BITES as a trademark for "frozen, packaged or
prepared Mexican foods, namely flour tortillas with
chicken, beef or cheese fillings."²

¹ Although the original application was filed by O.R.A.
Corporation, this application has been assigned to Trademark
Management Company. This assignment has been recorded with the
Assignment Branch of the U.S. Patent & Trademark Office at Reel
2624, Frame 0192.

² Serial No. 78/074,430, filed July 18, 2001, based on an
allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of the identified goods.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Examining Attorney contends that QUESADILLA BITES is merely descriptive of the identified goods because it immediately conveys information about their nature and size, namely, that they are bite size quesadillas. In support of the refusal, the Examining Attorney submitted an excerpt from The American Heritage Dictionary of the English Language (Electronic version, Third edition, 1992) wherein "**bite**" is defined as "*an amount of food taken into the mouth at one time, a mouthful.*"³ In addition, she

³ With her appeal brief, the Examining Attorney submitted a definition of the word "**quesadilla**" from the web site www.foodtv.com/terms. The Examining Attorney requests that we take judicial notice of this evidence. Although the Board has in the past taken judicial notice of dictionary definitions, in this case, we do not know if this material is available in printed format or is otherwise readily available. While we will not take judicial notice of the definition submitted by the Examining Attorney, we will nonetheless take judicial notice of the following definition of "**quesadilla**" taken from a readily available dictionary, namely, The American Heritage Dictionary of the American Language (Fourth edition, 2000): "A flour tortilla folded in half around a savory filling, as of cheese or beans, then fried or toasted."

submitted twelve third-party registrations of marks that contain the word BITES for food items. In each registration, BITES has been disclaimed. On the basis of this evidence, the Examining Attorney concluded that QUESADILLA BITES is merely descriptive of applicant's identified goods.

Applicant, on the other hand, argues that QUESADILLA BITES merely suggests information about the identified goods; that it does not describe the goods in any direct or immediate manner; that applicant's goods may be consumed in more than one bite; and that the Examining Attorney has improperly dissected the mark instead of considering the mark as a whole.

Further, applicant points to four registrations for marks which contain the word BITES with no disclaimer thereof. The registrations are: Registration No. 1,278,190 for the mark SPUD BITES for frozen potatoes, with a disclaimer of SPUD; Registration No. 1,399,736 for the mark BAGEL BITES for frozen bagels with various toppings, with a disclaimer of BAGEL; Registration No. 2,064,331 for the mark DYNA BITES and design for frozen breaded vegetables and cheese combinations; and Registration No. 2,322,663 for the mark HOT BITES for prepared appetizers,

with a Section 2(f) claim. Thus, applicant argues that it is entitled to registration of its mark.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality or property thereof. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Recovery, 196 USPQ 830 (TTAB 1977).

Applicant does not dispute that the word QUESADILLA is merely descriptive of applicant's goods. Also, as previously indicated, the Examining Attorney submitted twelve third-party registrations of marks that contain the

word BITES for food items, wherein the word has been disclaimed. This evidence supports the Examining Attorney's position that the word BITES is descriptive in connection with food. In this regard, we note that one of the registrations covers Mexican food: Registration No. 2,358,304 for the mark BORDER BITES for Mexican appetizers. Also, we note that in several of the registrations additional descriptive wording is disclaimed: Registration No. 2,554,663 for the mark FUDGE BROWNIE DOUGH BITES and design for candy, cakes, and bakery goods all containing brownie dough, with a disclaimer of "FUDGE BROWNIE DOUGH BITES;" Registration No. 2,416,552 for the mark NANCY'S BAGUETTE BITES for frozen appetizers consisting primarily of cheese and vegetable topping on baguette, with a disclaimer of "BAGUETTE BITES;" Registration No. 2,477,052 for the mark PEANUT BUTTER COOKIE DOUGH BITES and design for candy, cakes, and bakery goods all containing cookie dough, with a disclaimer of "PEANUT BUTTER COOKIE DOUGH BITES; and Registration No. 2,271,929 for the mark COOKIE DOUGH BITES and design for candy, cakes, and bakery goods all containing cookie dough, with a disclaimer of COOKIE DOUGH BITES.

In the absence of any limitations in applicant's identification of goods, we must assume that applicant's

quesadillas are of varying sizes, including small or appetizer size such that they may be consumed in a single mouthful. Thus, we find that the word BITES is descriptive of applicant's goods.

When these descriptive words QUESADILLA and BITES are joined in the mark QUESADILLA BITES, we find that the mark as a whole is merely descriptive of applicant's goods, in that it immediately conveys to consumers that applicant's goods are bite size quesadillas.

We admit that inconsistent Office handling of applications to register marks that include the word BITES is troubling. We note, however, that the mark HOT BITES issued under the provisions of Section 2(f), which is an admission of the descriptiveness of this mark. As to the other three registrations relied on by applicant, we do not know the circumstances under which they issued. Moreover, we do note that these registrations issued long before the third-party registrations put into the record by the Examining Attorney. Thus, it is entirely possible that a term, i.e., "bites," that may not earlier have been viewed as descriptive has come into common use and is now viewed as descriptive. In any event, as the Court noted in *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1546, 1566 (Fed. Cir. 2001), the Board must assess each mark on the

record submitted with the particular application. In this case, the fact that there are a handful of registrations for marks containing the word BITES without a disclaimer thereof does not outweigh the evidence of descriptiveness as shown by the dictionary definition and the numerous third-party registrations submitted by the Examining Attorney in which BITES has been disclaimed. Even applicant's ownership of an incontestable registration for the mark DURANGOS for cigars did not prohibit the refusal of the mark DURANGO on the ground that the mark was geographically deceptively misdescriptive for chewing tobacco. In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) ["[E]ach application for a registration of a mark for particular goods must be separately evaluated"].

Decision: The refusal to register under Section 2(e)(1) is affirmed.